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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,914	10/25/2005	Richard Coogan	4662-37	1188

23117 7590 10/05/2006

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901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON, VA 22203

EXAMINER
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NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/540,914

Applicant(s)

COOGAN ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/05</u>   | 6) <input type="checkbox"/> Other: _____                          |

1. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite molecular weights of polymeric species without stating whether they are average molecular weights and if so what type of average. It is therefore unclear if a polydispersity of exactly one is being claimed or if an average molecular weight is intended and if so what type of average is meant.

2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A. The instant claims recite molecular weights of polymeric species without stating whether they are average molecular weights and if so what type of average. The instant specification does not enable the ordinary skilled artisan to make the polymeric species having a polydispersity of exactly one.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12 are rejected under 35 U.S.C. 102(b) and (e) as being anticipated by WO 01/02455 A1 Irle et al. as translated by US Pat. No. 6559225 Irle et al., the disclosure of the US Patent being prior art itself under 102(e).

Irle discloses aqueous coatings, substrates coated therewith, and the corresponding method of coating these substrates at the abstract; column 2, lines 5-65, particularly 20-49 from which the component A is clearly intended to be a polyester oligomer, component B falls within the scope of the instantly claimed component i and its amount, component C falls within the scope of the instantly claimed component v and its amount, component D falls within the scope of the instantly claimed component vi and its amount, component E falls within the scope of the instantly claimed component ii and its amount, and component F falls within the scope of the instantly claimed component iii and its amount; column 3, lines 1-67; column 4, lines 1-67, particularly 12-36, 37-43, and 64-67; column 5, lines 1-67, particularly 1-12, 32-34, and 55-67; column 6, lines 1-67, particularly 1-15, with the OH value, Acid value, reactant amounts and reaction conditions being such that the polyurethane reactants A of the patentee are expected to necessarily fall within the broad, indefinite molecular weight range of the instant claims necessarily inherently, and lines 16-67; column 7, lines 1-67 of which the examples of these sections appear to actually use the instantly claimed ingredients and amounts thereof; and the remainder of the document. The patentee is silent regarding gloss. The patentee's coatings use

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the instantly claimed reactants and amounts thereof and are therefore necessarily inherently expected to possess the instantly claimed gloss properties. The PTO has no experimental facilities to test this. The burden is therefore on the applicant to show that the compositions of the patentee do not inherently possess the instantly claimed gloss. The instantly claimed component vi is claimed as being present in o-50 wt %. Therefore the component of the instant claim 5 can be used in 0 wt % also. The particle size implied by column 4, lines 64-67 and column 5, lines 1-2 and of the examples at column 6, lines 40-45; column 7, lines 39-42; and column 8, lines 1-6 and 35-42 falls within the scope of the instant claim 6. The acid values of the alkyds of the patentee's examples indicates that there is unreacted fatty acid left, which falls within the scope of the reactive diluent of the instant claim 7. The solids content and the amounts of water used by the patentee meet the instant claim 8. The method of the patentee's examples is that of the instant claim 12 and the coated substrates and the methods of coating them meet the instant claims 9-11.

6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/02455 A1 Irle et al. as translated by US Pat. No. 6559225 Irle et al., the disclosure of the US Patent being prior art itself under 102(e).

Irle discloses aqueous coatings, substrates coated therewith, and the corresponding method of coating these substrates at the abstract; column 2, lines 5-65, particularly 20-49 from which the component A is clearly intended to be a polyester oligomer, component B falls within the scope of the instantly claimed component i and its amount, component C falls within the scope of the instantly claimed component v and its amount, component D falls within the scope of the instantly claimed component vi and its amount, component E falls within the scope of the

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instantly claimed component ii and its amount, and component F falls within the scope of the instantly claimed component iii and its amount; column 3, lines 1-67; column 4, lines 1-67, particularly 12-36, 37-43, and 64-67; column 5, lines 1-67, particularly 1-12, 32-34, and 55-67; column 6, lines 1-67, particularly 1-15, with the OH value, Acid value, reactant amounts and reaction conditions being such that the polyurethane reactants A of the patentee are expected to necessarily fall within the broad, indefinite molecular weight range of the instant claims necessarily inherently, and lines 16-67; column 7, lines 1-67 of which the examples of these sections appear to actually use the instantly claimed ingredients and amounts thereof; and the remainder of the document. The patentee is silent regarding gloss. The patentee's coatings use the instantly claimed reactants and amounts thereof and are therefore necessarily inherently expected to possess the instantly claimed gloss properties. The PTO has no experimental facilities to test this. The burden is therefore on the applicant to show that the compositions of the patentee do not inherently possess the instantly claimed gloss. The instantly claimed component vi is claimed as being present in 0-50 wt %. Therefore the component of the instant claim 5 can be used in 0 wt % also. The particle size implied by column 4, lines 64-67 and column 5, lines 1-2 and of the examples at column 6, lines 40-45; column 7, lines 39-42; and column 8, lines 1-6 and 35-42 falls within the scope of the instant claim 6. The acid values of the alkyds of the patentee's examples indicates that there is unreacted fatty acid left, which falls within the scope of the reactive diluent of the instant claim 7. The solids content and the amounts of water used by the patentee meet the instant claim 8. The method of the patentee's examples is that of the instant claim 12 and the coated substrates and the methods of coating them meet the instant claims 9-11.

It would have at least been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed components and amounts thereof in a composition having the instantly claimed low gloss because these amounts of ingredients are encompassed by the patentee and it is within the ability of the ordinary skilled artisan to choose the composition parameters so as to obtain glossy or non-glossy coatings, as indicated by the patentee's silence about these properties it is taken that the compositions of the patentee encompass both glossy and non-glossy compositions, and the choice of non-glossy compositions is a matter of taste. No unexpected results stemming from any differences between the cited prior art and the instant claims are seen in a manner commensurate in scope with the cited prior art and the instant claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

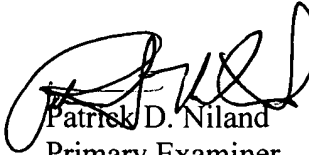
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patrick D. Niland  
Primary Examiner  
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